

UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 5366

Harri KORPELA et al.

Art Unit: 2616

Application No.: 10/028,950

Examiner: Steven H. D. Nguyen

Filed: December 18, 2001

Attorney Dkt. No.: 059643.00139

For: FORMING A COMMUNICATION NETWORK

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 1, 2007

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005, Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 21-47 in the above identified application. Claims 21-47 were finally rejected in the Office Action dated September 4, 2007. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

Claims 30-47 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action asserted that the claims recite subject matter that was not described in such a way as to show that the inventor(s) possessed the invention at the time the application was filed. Specifically, the Office Action asserted that "The specification does not disclose a software tool to be performed [sic] the functions of the claims." This rejection constitutes clear error, as will be explained below.

As an initial matter, claims 30-47 do not specifically recite "a **software tool**," but rather "a network modeling tool" (see the preambles of claims 30 and 39, upon which the remainder of the rejected claims depend). Thus, it is not necessary that it be shown that "a **software tool**" was possessed, but only that "a network modeling tool" was possessed.

Furthermore, possession of "a network modeling tool" can be clearly seen at least from, for example, page 1, lines 35-36, of the present application. Although that passage does not use the particular expression, "a network modeling tool," the passage states: "The invention offers **an arrangement** and a method **to form a communication network**." One of ordinary skill in the art would recognize that such an arrangement could be referred to as a network modeling tool, particularly in view of the discussion following the identified passage (e.g. at page 2, lines 1-15, of the present application) in which various "modules" and the like are mentioned in the

implementation of an embodiment of the present invention. *See also, for further example*, page 2, lines 27-30, of the present application (“the inventive arrangement comprises several modules”). Thus, “a network modeling tool” was a concept that was clearly possessed by the inventors at the time the application was filed, and consequently the rejection should be reversed.

The “Response to Arguments” section of the Office Action argued that “arrangement does not means [sic] a software tool because the specification does not disclose arrangement being a software tool.” This argument does not support the rejection, because in addition to the literal disclosure of the specification (*i.e.* in addition to the words used to describe the invention), patent applicants are entitled to rely on the understanding of one of ordinary skill in the art. One of ordinary skill in the art would have understood the disclosed “arrangement” to include (to provide two examples) a general purpose computer programmed to execute software modules, or an application specific integrated circuit (ASIC) having a modular design, in view of the remaining disclosure in the application.

There is no requirement that the term “tool” be used in the specification in order to fully comply with 35 U.S.C. 112. Section 112 states that the “specification shall contain a written description of the invention.” 35 U.S.C. §112. The Federal Circuit has held that “[t]o fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed.” *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). The Federal Circuit has explained, however, that “[t]he disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue.” *Id.* *See additionally, Kao Corp. v. Unilever United States, Inc.*, 78 USPQ2d 1257, 1260 (Fed. Cir. 2006). In other words, there is no requirement that the precise language used in the claims appear in the specification, in order to satisfy the written description requirement. The concept claimed is fully supported in the specification, in such a way that one of ordinary skill in the art would clearly conclude that the inventor invented what is claimed. Therefore, the claims fully comply with the written description requirement, including the “possession” aspect of that requirement.

The “Response to Arguments” section continued by asserting that the specification “just discloses that manual work often use [sic] to handle the process and expansion of a network in parallel.” That is an incorrect description, because it is an incomplete description of what the specification indicates. Nevertheless, regardless of the inaccuracy of the summary, the fact of the matter is that the specification contrasts the invention with manual work. The Office Action does not appear to have contested that fact, and consequently one of ordinary skill in the art would clearly recognize that the inventors invented something other than manual work, namely a tool.

The “Response to Arguments” section further continued by asserting that “However, no single manual work to handle both the process and expansion of a network.” Although this assertion is not a sentence, as best understood, the Office Action was attempting to assert that the specification is contrasting one manual process (the invention under the Office Action’s interpretation) with two manual processes (the previous situation under the Office Action’s

interpretation). This interpretation is clearly erroneous. The specification actually states: "Still, there is no single, suitable **arrangement to handle** both the process and the expansion of the expansion of a network." (emphases added) (page 1, lines 28-30). Accordingly, one of ordinary skill in the art would not conclude that the invention was merely the simplification of two manual processes to one manual process.

The "Response to Arguments" section finally concludes, "It clearly does not disclose a software tool to implement the function of the claims." For the reasons set forth above, this conclusion is demonstrably erroneous. The only thing that the Office Action has demonstrated is that the term "software tool" is not used; but the lack of usage of the term "software tool" in the original specification is not legally significant. Thus, it is respectfully that the rejection be reversed as unsupported and consequently clearly erroneous.

Claims 21-47 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Office Action stated that "technical solutions" is "vague and indefinite because it's unclear what it's constituted for [sic]," and that "providing a comparison of different technical solutions to a user based on the modeling" is "vague and indefinite because it's unclear what a comparison of different technical solutions is provided to a user [sic]." This rejection is clearly erroneous as will be discussed below.

As explained in the response filed June 20, 2007, the term "technical solutions" is described in the specification at, for example, page 3, lines 1-8. The fact that the term "technical solutions" is a broad term does not imply that it is an indefinite term.

One of ordinary skill in the art would understand the metes and bounds of the invention conveyed by the term "technical solutions." The term "technical solutions" is composed of two words, "technical" and "solutions." The word "technical" is an adjective that describes the type of solutions, and specifies that those solutions are in the technological arts. The word "solutions" is a plural noun that describes the resolution of a problem. Accordingly, one of ordinary skill in the art would understand that "technical solutions" refers to technological resolutions to problems, and would, therefore, understand the metes and bounds of the invention.

Likewise, the concept of "providing a comparison of different technical solutions to a user based on the modeling" is discussed in the specification of the present invention at page 5, line 24, to page 6, line 5. In view of the discussion of that concept provided therein, one of ordinary skill in the art would understand that "providing a comparison of different technical solutions to a user based on the modeling" refers to the presentation of, for example, a respective "rough picture of the transmission needs" or a respective "more detailed picture" of the impact on network formation presented by respective technical solutions, and would, therefore, understand the metes and bounds of the invention. Thus, it is respectfully requested that the rejection be reversed as clearly erroneous.

Claims 21-47 were rejected under 35 U.S.C. 101 as directed to non-statutory subject matter, because the claimed invention is allegedly "not limited to a practical application." Applicants respectfully request that this rejection be reversed as clearly improper.

The Office Action stated that “Viewed as a whole, the claimed invention merely expresses a method, tool and system for providing a comparison of a value to a user therefore, the claimed invention is not practically applied.” This statement is self-contradictory, incorrect, and legally irrelevant.

The Office Action’s statement is self-contradictory, because “providing a comparison of a value to a user” is something that is a practical application *per se*. In *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596, at 1601-02 (Fed. Cir. 1998), the Federal Circuit indicated that the transformation of data to produce a share price was a practical application of a mathematical algorithm because it produces the share price. Providing a comparison of a value to a user would be at least the same – in terms of qualifying as statutory subject matter – as providing a value (such a share price) alone to a user. Indeed, if providing a value alone is patentable (as *State Street* established), then providing a comparison of a value is even more clearly patentable. Thus, for this independent reason, the rejection should be reversed, because it contradicts itself.

The Office Action’s statement is incorrect (particularly with respect to the word “merely”) because the claimed invention does more than just provide a comparison of a value to a user, the claimed invention as recited in claim 21, for example, provides a comparison of different technical solutions to a user based on network modeling. The Office Action’s comment that such a view is a whole view (“Viewed as a whole”) consequently is clearly erroneous. Thus, for this independent reason, the rejection should be reversed, because the Office Action has not truly viewed the invention as a whole in asserting that it “merely” does what the Office Action stated.

Finally, the Office Action’s comment is legally irrelevant. Whether or not “the claimed invention is practically applied” does not decide whether the claimed invention recites statutory subject matter. Instead, the question is whether the claimed invention is useful – not whether it is “limited to a practical application.” The claimed invention is useful, a fact that the Office Action in no way disputes. Consequently, the claimed invention clearly and unmistakably qualifies as statutory subject matter under 35 U.S.C. 101, and the rejection should be reversed.

It should be noted that some inventions might arguably be useful, but yet fall within a judicial exception. Nevertheless, except as discussed below, none of the judicial exceptions have been identified as relevant by the Office Action, and there is consequently no reason of record to suppose that any of the claims of the present application fall within a judicial exception to the general principle that “Congress intended statutory subject matter to “include anything under the sun that is made by man.” S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952), H.R. Rep. No. 1923, 82d Cong., Sec. 2d Sess., 6 (1952).” *Diamond v. Diehr*, 450 US 175, 209 USPQ 1, 6 (1981). Thus, it is respectfully requested that this rejection be reversed as clearly improper.

In the “Response to Arguments” section, the Office Action further argued that “the claims are an abstract idea....” This would – on its face – seem to place the claims within a

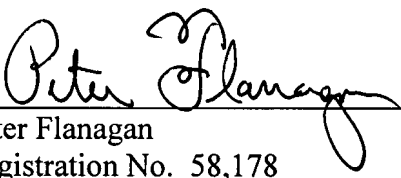
judicial exception. However, the assertion that the claims are "an abstract idea" is clearly incorrect.

A "tool" as recited in claims 30-47 is plainly not an "abstract idea," because a tool has real-world existence and real-world value. Furthermore, methods that involve providing information to a user (such as claims 21-29) are also plainly not abstract ideas because the provision of information to a user is a real-world interaction that has real-world value. Accordingly, the assertion that claims are "an abstract idea" is clearly erroneous.

The "Response to Arguments" section of the Office Action attempted to justify the statement that the claims are "an abstract idea" using the rationale that "they just compared [sic] the technical solutions and provider [sic] the different result to user [sic]." There's simply no connection between the proffered justification and the concept of an "abstract idea." The fact that method and tools of the present invention provide results to users clearly gives them real-world value and differentiates them from mere abstract ideas. Accordingly, the justification for the rejection is clearly improper and the rejection should be reversed.

Reconsideration and reversal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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